UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/771,564	01/30/2001	Akihiro Furukawa	108478	9409

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ART UNIT	PAPER NUMBER
2686	

DATE MAILED: 03/04/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on <u>24 December 2004</u>.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>2-22,24 and 27-49</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>2-22, 24, 27-49</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage
application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☐ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1.   A request for continued examination under 37 CFR 1.114, including the fee set forth in

37 CFR 1.17(e), was filed in this application after final rejection. Since this application is

eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e)

has been timely paid, the finality of the previous Office action has been withdrawn pursuant to

37 CFR 1.114. Applicant's submission filed on 12/24/04 has been entered.

Claim Rejections - 35 USC § 103

2.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

3.   **Claims 24, 27-33, 35-45, 47-49,** are rejected under 35 U.S.C. 103(a) as being

unpatentable over Chapman (US Patent Number 6,522,421 B1) in view of Stenman et al. (US

Patent Number 6,223,029 B1).

Regarding claims 24, 38, Chapman teaches a control method of controlling an image-forming

device, comprising the steps of:

a) receiving image information from an external device 11 (col 3 lines 29-35);

b) storing the image information in a memory(col 3 lines 35-37); and

c) receiving an instruction to print the image information (col 3 lines 33-37); and

d) executing printing of the image information in accordance with the instruction (col 3 lines 60-67, col 4 lines 1-17).

Chapman fails to c) executing printing of the print data from a cellular phone. However Stenman teaches c) executing printing of the print data from a cellular phone (col 7 lines 1-24, col 15 lines 20-21).). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to combine the above teaching of Stenman with Chapman, in order to provide security to the user not only for sensitivity of the information but also the accessibility and location of the receiving equipment

Regarding claims 27, 39, Chapman teaches a controlling method comprising a step of :

e) outputting a signal indicating that the image information is stored in the memory (col 3 lines 33-37, col 4 lines 2-18), wherein the instruction is received from the cellular phone after the signal is output. Chapman fails to teach a method wherein the instruction is received from the cellular phone. However Stenman teaches a method wherein the instruction is received from the cellular phone (col 7 lines 1-24, col 15 lines 20-21). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to combine the above teaching of Stenman with Chapman, in order to provide security to the user not only for sensitivity of the information but also the accessibility and location of the receiving equipment.

Regarding claims 28, 35, 40, Chapman teaches a controlling method wherein the instruction is an email message transmitted in an e-mail format (col 3 lines 18-20). Chapman fails to teach a method wherein the instruction is received from the cellular phone. However Stenman teaches a method wherein the instruction is received from the cellular phone (col 7 lines 1-24, col 15 lines 20-21).). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to combine the above teaching of Stenman with Chapman, in order to provide security to the user not only for sensitivity of the information but also the accessibility and location of the receiving equipment.

Regarding claims 29, 41, Chapman teaches a controlling method wherein the instruction is an email message transmitted in via a Web service (col 3 lines 43-53). Chapman fails to teach a method wherein the instruction is received from the cellular phone However Stenman teaches a method wherein the instruction is received from the cellular phone (col 7 lines 1-24, col 15 lines 20-21).). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to combine the above teaching of Stenman with Chapman, in order to provide security to the user not only for sensitivity of the information but also the accessibility and location of the receiving equipment.

Regarding claims 30, 36, 42, 48, Chapman teaches a controlling method wherein the image forming device has a URL (Internet address), and the instruction is transmitted to the image forming apparatus (col 3 lines 43-65). Chapman fails to teach a method wherein the instruction is received from the cellular phone. However Stenman teaches a method wherein the instruction is

received from the cellular phone (col 7 lines 1-24, col 15 lines 20-21). Therefore, it would have

been obvious to one of ordinary skill in the art at the time of the invention to combine the above

teaching of Stenman with Chapman, in order to provide security to the user not only for

sensitivity of the information but also the accessibility and location of the receiving equipment.

Regarding claims 31, 43, Chapman fails to teach a controlling method wherein the instruction

from the cellular phone is transmitted via an audio guidance. Chapman fails to teach a method

wherein the instruction is received from the cellular phone However Stenman teaches a method

wherein the instruction from the cellular phone is transmitted via an audio guidance (col 7 lines

52-59). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the

invention to combine the above teaching of Stenman with Chapman, in order to provide security

to the user not only for sensitivity of the information but also the accessibility and location of the

receiving equipment.

Regarding claims 32, 44, the control method wherein the instruction from the cellular phone is

transmitted in response to the audio guidance. Chapman fails to teach a method wherein the

wherein the instruction from the cellular phone is transmitted in response to the audio guidance.

However Stenman teaches a method wherein the instruction from the cellular phone is

transmitted in response to the audio guidance (col 7 lines 52-59). Therefore, it would have been

obvious to one of ordinary skill in the art at the time of the invention to combine the above

teaching of Stenman with Chapman, in order to provide security to the user not only for

sensitivity of the information but also the accessibility and location of the receiving equipment.

Regarding claims 33, 45, Chapman teaches a controlling method/printing system comprising the steps of:

f) detecting an e-mail address from the image information stored in the memory (col 3 lines 33-37); and

g) sending an e-mail message to the designation of the detected e-mail address (col 3 lines 33-37), the e-mail message urging a user to transmit the instruction to the image forming device (col 3 lines 60-67, col 4 lines 1-18). Chapman fails to teach a method wherein the instruction is received from the cellular phone However Stenman teaches a method wherein the instruction is received from the cellular phone (col 7 lines 1-24, col 15 lines 20-21).). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to combine the above teaching of Stenman with Chapman, in order to provide security to the user not only for sensitivity of the information but also the accessibility and location of the receiving equipment.

Regarding claim 37, Chapman teaches a control method wherein the URL includes a link to a page to instruct the **execution of the printing**, and the instruction is sent to image forming device has a URL (Internet address), and the instruction is transmitted to the image forming apparatus (col 3 lines 43-65).

d) executing printing of the image information in accordance with the instruction (col 3 lines 60-67, col 4 lines 1-17).

Chapman fails to c) executing printing of the print data from a cellular phone. However Stenman

teaches c) executing printing of the print data from a cellular phone (col 7 lines 1-24, col 15 lines

20-21).). Therefore, it would have been obvious to one of ordinary skill in the art at the time of

the invention to combine the above teaching of Stenman with Chapman, in order to provide

security to the user not only for sensitivity of the information but also the accessibility and

location of the receiving equipment

Regarding claims 47, 49, Chapman teaches a printing system method wherein the URL (Internet

address) includes link to a page to instruct the printing (col 3 lines 33-56), and the instruction is

sent to the image forming device by accessing the link (col 3 lines 57-67, col 4 line 1).

Chapman fails to teach a method wherein the instruction is received from the cellular phone.

However Stenman teaches a method wherein the instruction is received from the cellular phone

(col 7 lines 1-24, col 15 lines 20-21). Therefore, it would have been obvious to one of ordinary

skill in the art at the time of the invention to combine the above teaching of Stenman with

Chapman, in order to provide security to the user not only for sensitivity of the information but

also the accessibility and location of the receiving equipment.

4.   **Claims 34, 46,** are rejected under 35 U.S.C. 103(a) as being unpatentable over Chapman

(US Patent Number 6,522,421 B1) in view of Stenman et al. (US Patent Number 6,223,029 B1)

in further view of Peyser International publication WO 94/26059.

Regarding claim 34, 46, Chapman fails to teach a method wherein the instruction is received

from the cellular phone. However Stenman teaches a method wherein the instruction is received

from the cellular phone (col 7 lines 1-24, col 15 lines 20-21). Therefore, it would have been

obvious to one of ordinary skill in the art at the time of the invention to combine the above

teaching of Stenman with Chapman, in order to provide security to the user not only for

sensitivity of the information but also the accessibility and location of the receiving equipment.

Chapman modified by Stenman fails teaches a control method/printing system wherein the

image information forming device determines whether the image information is

confidential and the printing is executed when the instruction including a predetermined

code is transmitted from the cellular phone.

However Peyser teaches a control method/printing system wherein the **image information**

forming device determines whether the image information is confidential and the printing

is executed when the instruction including a predetermined code is transmitted from the

cellular phone (page 6 lines 13-17, page 7 lines 21-25, page 8 lines 31-35, page 9 lines 5-16).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the

invention to combine above teaching of Peyser with Chapman modified by Stenman, in order to

provide security to the user not only for sensitivity of the information but also the accessibility

and location of the receiving equipment.

Response to Arguments

5.   Applicant's arguments filed 11/29/04 have been fully considered but they are not

persuasive.

In response to the applicant's argument that *"the art at the time of the invention would have had motivation to combine the teachings of Chapman and Stenman, the combination of Chapman and Stenman fails to disclose or suggest the combination of features recited in each of independent claim 24 and 38, including, iner alia, storing the image information in a memory and receiving an instruction to print the image information from a cellular phone, as recited in claim 24, and* <u>a memory in which the image information is stored and a cellular phone including a communication unit that transmits an instruction to the image forming device, wherein a controller controls the printing to execute the printing when the instruction is transmitted from the cellular phone</u>*, as recited in claim 38 because neither Chapman or Stenman discloses or suggests independent steps of storing image information and instructing or executing printing thereof based on an instructing from a cellular phone"*

The Examiner states that Stenman teaches The document files may also be formatted in TIFF, JPEG, or GIF as examples of image formats. The marking engine provides hard copy output of the information input from the various sources. The rasterized files may be stored in a multipage job buffer (JIB) (col 2 lines 47-52). The *printer that receives the file and starts interpreting the page description language. The printer detects this embedded email information and extracts the email addresses. A program (image information) stored in memory in the printer for detecting embedded email information is provided in the appendix (col 3 lines 32-37).* The controller may include a fax server that can serve plural fax modems on a Local Area Network (LAN), a wide area network (WAN) or other electronic mail (email) system such as telephone lines. When the data is input from the server 30 to

the RIP, the RIP strips the embedded email address information and the RIP

provides status information relative to raster image processing of the

document such as PDL errors and outputs the email address and this status

information to a message store agent in the printer. The message store agent

also receives an output of the printer controller representing various

information concerning the printing of the document job associated with that

address. The message store agent combines the address and information

relative to the finished job in a message store. The message is then output

to a message transport agent which outputs the message via telephone lines or

other communication link, which could be wireless to, for example, a fax

server allowing the person who sent the file to be printed to receive the

email message that the job is complete and the nature of the finishing

operation col 3 lines 65-67, col 4 lines 1-17).

Conclusion

6.   **Any responses to this action should be mailed to:**

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Naghmeh Mehrpour whose telephone number is 703-308-7159.

The examiner can normally be reached on 8:00- 6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Lester Kincaid be reached on (703) 306-3061.

The fax phone number for the organization where this application or proceeding is

assigned is 703-872-9306. Information regarding the status of an application may be obtained

from the Patent Application Information Retrieval (PAIR) system. Status information for

published applications may be obtained from either Private PAIR or Public PAIR. Status

information for unpublished applications is available through Private PAIR only. For more

information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions

on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-

9197 (toll-free).

NM

February 24, 2005